

REMARKS

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1-20 are pending. In this Amendment, Claims 1, 5, 11 and 12 are amended. No new matter is added. Any paragraph numbers below refer to the paragraph numbers in United States Published Patent Application No. 2004-0157074.

Applicant thanks Examiner Zirker for the courtesies extended to Applicant's representative during a December 22, 2005, telephone interview (Examiner Interview) during which the outstanding rejection was discussed. Applicant's separate record of the substance of the interview is contained in the comments below.

A. Response to Objections to Title and Abstract

As requested by the Examiner at Section 1 of the Office Action, the Title and Abstract have been amended to clarify the Title and Abstract for the present application.

B. Response to Rejection of Claims 5 and 11-20 under 35 U.S.C. § 112(a), second paragraph.

At Sections 2 and 3 of the Office Action, Claims 5 and 11-20 are rejected under 35 U.S.C. § 112, second paragraph. The Examiner is thanked for pointing out the specific objectionable language. As requested by the Examiner, the claims have been amended to comply with the requirements of 35 U.S.C. § 112, second paragraph and to more distinctly define the subject matter of the present invention.

C. Response to Rejection of Claims 1, 2, 4-7, 11 and 14-17 under 35 U.S.C. § 102(a) as being as being unpatentable over Hubbard.

At Sections 4 and 5 of the Office Action, Claims 1, 2, 4-7, 11 and 14-17 are rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application No. 2003-0219564 to Hubbard (Hubbard). This rejection is respectfully traversed with respect to the claims as currently presented.

1. **Rejection of any claims in the present application over Hubbard is *prima facie* improper.**

As noted at page of the Office Action, the Hubbard reference and the present application share the same inventor. Therefore, as Applicant's representative discussed with the Examiner during the Examiner Interview, a rejection of any of the claims in the present application over Hubbard under 35 U.S.C. § 102(a) is *prima facie* improper. According to long established Federal Circuit case law precedent, that an applicant's own prior work may not be used to anticipate his later invention unless that prior work is such as to constitute a statutory bar under 35 U.S.C. § 102(b), see *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593, 1608 n. 47 (Fed. Cir. 1986) and D. Chisum, *Patents* (2005) § 3.08[2] [a] (copy attached). Therefore, Hubbard cannot anticipate any of the claims in the present application under 35 U.S.C. § 102(a). Also, because Hubbard was published November 27, 2003, less than a year before the present application's filing date of February 11, 2004, Hubbard is also not available as a reference under 35 U.S.C. § 102(b) against any of the claims in the present application. Therefore, Hubbard is not available as a reference with respect to any of the claims in the present application.

2. **The rejection of Claims 2, 4-7, 11 and 14-17 over Hubbard should be withdrawn because it is *prima facie* improper.**

In summary, for at least the reasons discussed above, the rejection of Claims 1, 2, 4-7, 11 and 14-17 over Hubbard is *prima facie* improper and should be withdrawn.

D. **Response to Rejection of Claims 3, 8-10, 12, 13 and 18-20 under 35 U.S.C. § 103(a) as being as being unpatentable over Hubbard.**

At Sections 6 and 7 of the Office Action, Claims 3, 8-10, 12, 13 and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hubbard. This rejection is respectfully traversed with respect to the claims as currently presented.

For the reasons discussed above and discussed during the Examiner Interview, Hubbard is not available as a reference with respect to the present application. Therefore,

the rejection of Claims 3, 8-10, 12, 13 and 18-20 over Hubbard is *prima facie* improper and should be withdrawn.

E. Response to Rejection of Claims 1-20 under 35 U.S.C. § 103(a) as being as being unpatentable over Venable ‘785 or Venable ‘812, each taken individually, or in view of either Hubbard or WO98/56866.

At Sections 6 and 8 of the Office Action, Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,456,785 to Venable (Venable ‘785) or U.S. Patent No. 4,996,812 to Venable (Venable ‘812), either taken individually, or in view of Hubbard or International Patent No. WO98/56866 (WO’ 866). This rejection is respectfully traversed with respect to the claims as currently presented.

1. Rejection of claims 1-20 over Venable ‘785 is *prima facie* improper.

a. Rejection of claims 1-10 over Venable ‘785 is *prima facie* improper.

i. The Office Action must show how all of the claim features are taught or suggested by Venable ‘785.

As set forth in MPEP § 706.02(j), “To establish a *prima facie* case of obvious[ness] . . . The prior art reference (or references) when combined must teach or suggest *all of the claim limitations*” (Emphasis added). As also set forth in 37 C.F.R. § 1.104(c)(2), “In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The *pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.*” (Emphasis added).

For at least the following reasons, the rejection of claims 1-10 over Venable ‘785 has failed to comply requirements of MPEP § 706.02(j) and 37 C.F.R. § 1.104(c)(2).

ii. **The Office Action has failed to show where all of the features of Claims 1-10 are taught or suggested by Venable '785.**

Claim 1, both as originally filed and currently presented, claims a covering product including the features of "a fabric layer attached to a lower side of [a thermoplastic] membrane . . . and an adhesive covering at least a portion of a lower side of said fabric layer for allowing said covering product to be adhered to a building structure." Claims 2-10 depend from Claim 1, either directly or indirectly, and, accordingly, also include the above claimed features. In rejecting claims 1-10 over Venable '785, the Office Action makes the following conclusory statements:

First Conclusory Statement

The primary references each disclose (note particularly Venable '785, the Abstract, Col. 1, lines 9-15, lines 40-53, Col 2, lines 26-43, col. 3, lines 4-15; Venable '812, Col 1, lines 7-24, line 47-Col 2, line 17) substantial anticipations of at least the broad article and method claims except that the '785 patent utilizes a strip of double side adhesive tape for the outer adhesive layer covering the fabric, while the '812 patent has a fabric layer, i.e. matting, at least partially embedded in the adhesive (Col. 1, lines 18-20) before becoming solidified. (see Office Action, pp. 3-4).

Second Conclusory Statement

However, these limitations are believed to be, if not anticipatory elements of applicant's claims, teachings that are sufficient to put the claimed embodiments within the ordinary skill of the art." (See Office Action, p. 4).

The First Conclusory Statement fails to properly to identify any text in Venable '785, that teaches or suggests the claimed features of "a fabric layer attached to a lower side of [a thermoplastic] membrane . . . and an adhesive covering at least a portion of a lower side of said fabric layer for allowing said covering product to be adhered to a building structure." The Second Conclusory Statement fails to cite any support for its allegation and does not explain how Venable '785 teaches or suggest any feature of Claims 1-10, much less the claimed features of "a fabric layer attached to a lower side of [a thermoplastic] membrane . . . and an adhesive covering at least a portion of a lower side of said fabric layer for allowing said covering product to be adhered to a building structure." Therefore, contrary

to the requirements of 37 C.F.R. § 1.104(c)(2), the Office Action never properly explains the “pertinence” of Venable ‘795 to Claims 1-10.

iii. **Venable ‘785 does not teach or suggest all of the features of Claims 1-10.**

Venable also does not teach or suggest the claimed feature of “a fabric layer attached to a lower side of [a thermoplastic] membrane . . . and an adhesive covering at least a portion of a lower side of said fabric layer for allowing said covering product to be adhered to a building structure.” For example, the “strip of double sided adhesive tape” discussed in the First Conclusory Statement quoted above does not: (1) cover at least a portion of a fabric layer nor (2) allow a covering product to be adhered to a roofing structure. As described in Venable ‘785:

The matting [Venable 785’s alleged fabric material] and polymeric film are somewhat narrower than the rubber or thermoplastic sheet [thermoplastic membrane], thus leaving an *exposed selvedge of rubber on both longitudinal edges of the underside of the roofing material*. A strip of double sided tape and/or primer is optionally applied to one of these selvedges as the composite material is cooling to provide a convenient way for adjacent *sheets of roofing to be attached to each other* (see Venable, Col. 2, lines 36-43, emphasis added).

Based on the above description in Venable ‘785, the double sided tape is applied directly to a thermoplastic membrane and is used to adhere sheets of roofing material to each other and not to a building structure. Accordingly, the rejection of Claims 1-10 over Venable ‘785 does not meet the requirements of MPEP § 706.02(j) and, therefore, the rejection of Claims 1-10 over Venable ‘785 is *prima facie* improper for this additional reason.

b. **Rejection of Claims 11-20 over Venable ‘785 is *prima facie* improper.**

i. **The Office Action must show how all of the claim features are taught or suggested by Venable ‘785.**

The requirements of MPEP § 706.02(j) and 37 C.F.R. § 1.104(c)(2) are set forth above in Section E(1)(a)(i).

ii. **The Office Action has failed to show where all of the features of Claims 1-10 are taught or suggested by Venable ‘785.**

Claim 11, both as originally filed and currently presented, claims mounting at least one membrane on a building structure the features of adhering a first membrane on the building structure, wherein the first membrane is adhered to the building structure by a first adhesive coated on a lower side of a first fabric layer bonded to the first membrane. Claims 12-20 depend from Claim 11, either directly or indirectly, and, accordingly, also include the above claimed features. In rejecting claims 11-20 over Venable ‘785, the Office Action relies on the First and Second Conclusory Statements quoted in Section E(1)(a)(ii) above. The First Conclusory Statement fails to properly to identify any text in Venable ‘785, that teaches or suggests the claimed features of adhering a first membrane on the building structure, wherein the first membrane is adhered to the building structure by a first adhesive coated on a lower side of a first fabric layer bonded to the first membrane. The Second Conclusory Statement fails to cite any support for its allegation and does not explain how Venable ‘785 teaches or suggest any feature of Claims 11-20, much less the claimed features of adhering a first membrane on the building structure, wherein the first membrane is adhered to the building structure by a first adhesive coated on a lower side of a first fabric layer bonded to the first membrane. Therefore, contrary to the requirements of 37 C.F.R. § 1.104(c)(2), the Office Action never properly explains the “pertinence” of Venable ‘795 to Claims 11-20.

iii. **Venable '785 does not teach or suggest all of the features of Claims 11-20.**

Venable also does not teach or suggest the currently claimed features of adhering a first thermoplastic membrane on the building structure, wherein the first thermoplastic membrane is adhered to the building structure by a first adhesive coated on a lower side of a first fabric layer bonded to the first membrane. For example, the "strip of double sided adhesive tape" discussed in the First Conclusory Statement quoted above does not: (1) cover at least a portion of a fabric layer nor (2) allow a covering product to be adhered to a roofing structure. As described in Venable '785:

The matting [Venable 785's alleged fabric material] and polymeric film are somewhat narrower than the rubber or thermoplastic sheet [thermoplastic membrane], thus leaving an *exposed selvedge of rubber on both longitudinal edges of the underside of the roofing material*. A strip of double sided tape and/or primer is optionally applied to one of these selvedges as the composite material is cooling to provide a convenient way for adjacent *sheets of roofing to be attached to each other* (see Venable, Col. 2, lines 36-43, emphasis added).

Based on the above description in Venable '785, the double sided tape is applied directly to a thermoplastic membrane and is used to adhere sheets of roofing material to each other and not to a building structure. Accordingly, the rejection of Claims 11-20 over Venable '785 does not meet the requirements of MPEP § 706.02(j) and, therefore, the rejection of Claims 11-20 over Venable '785 is *prima facie* improper for this additional reason.

c. **The rejection of Claims 1-20 over Venable '785 should be withdrawn because it is *prima facie* improper.**

In summary, for at least the reasons discussed above, the rejection of Claims 1-20 over Venable '785 is *prima facie* improper and should be withdrawn.

2. **Rejection of claims 1-20 over Venable '812 is *prima facie* has been obviated with respect to claims as currently presented.**

a. **All of the claim features must be taught or suggested by Venable '812.**

The requirements of MPEP § 706.02(j) are set forth above in Section E(1)(a)(i).

b. **Venable '812 does not teach or suggest all of the features of Claim 1.**

The rejection of Claims 1-10 has been obviated with respect to Claims 1-10 as currently presented. Claim 1 as currently presented claims a covering product that includes an adhesive on a fabric layer for adhering the covering product on a building structure, wherein the adhesive is pre-applied to the fabric layer prior to adhering the covering product on the building structure. However, Venable '812 only describes pressing a "membrane 18" including "upper flexible EPDM rubber layer 20 together with a non-woven polyester fleece like layer [fabric layer] 22 secured to the underside of the rubber layer" into an adhesive 15 on top of a metal decking 12 and a layer of insulated foam 14 (see Col. 2, lines 33-36 and Col. 3, lines 3-4 and 15-27). As can be seen in Venable '812, Venable '812 describes applying an adhesive to a building structure (the substrate comprising the layer of insulated foam 14 and metal decking 12) to which the fabric layer is adhered. There is no teaching or suggestion in Venable '812 of using an adhesive that is pre-applied to a fabric layer of a covering product *prior* to adhering the covering product to a building structure as claimed by Claim 1. Therefore, Venable does not teach or suggest all of the features of Claim 1 as required by MPEP § 706.02(j), and Claim 1 is patentable over Venable '812.

c. **Venable '812 does not teach or suggest all of the features of Claims 2-10.**

Claims 2-10 depend from Claim 1, either directly or indirectly, and, accordingly, also include the patentable features of Claim 1. Therefore, Claims 2-10 are patentable over Venable '812 for at least the reasons discussed with respect to Claim 1.

d. **Venable '812 does not teach or suggest all of the features of Claim 11.**

The rejection of Claims 11-20 has been obviated with respect to Claims 11-20 as currently presented. Claim 11 as currently presented claims a thermoplastic membrane being adhered to a building structure by an adhesive coated on a lower side of a fabric layer bonded to the first membrane, wherein the adhesive is pre-applied to the first fabric layer prior to adhering the membrane on the building structure. However, Venable '812 only describes pressing a "membrane 18" including "upper flexible EPDM rubber layer 20 together with a non-woven polyester fleece like layer [fabric layer] 22 secured to the underside of the rubber layer" into an adhesive 15 on top of a metal decking 12 and a layer of insulated foam 14 (see Col. 2, lines 33-36 and Col. 3, lines 3-4 and 15-27). As can be seen in Venable '812, Venable '812 describes applying an adhesive to a building structure (the substrate comprising the layer of insulated foam 14 and metal decking 12) to which the fabric layer is adhered. There is no teaching or suggestion in Venable '812 of using an adhesive that is pre-applied to a fabric layer bonded to a membrane *prior* to adhering the membrane to a building structure as claimed by Claim 11. Therefore, Venable does not teach or suggest all of the features of Claim 1 as required by MPEP § 706.02(j), and Claim 11 is patentable over Venable '812.

c. **Venable ‘812 does not teach or suggest all of the features of Claims 12-20.**

Claims 12-20 depend from Claim 11, either directly or indirectly, and, accordingly, also include the patentable features of Claim 11. Therefore, Claims 12-20 are patentable over Venable ‘812 for at least the reasons discussed with respect to Claim 11.

3. **Rejection of Claims 1-20 over Venable ‘785 or Venable ‘812 in view of Hubbard is *prima facie* improper.**

For the reasons set forth in Section C, Hubbard may not be properly used as a reference with respect to any of the claims in the present application. Therefore, the rejection of Claims 1-20 over Venable ‘785 or Venable ‘812 is *prima facie* improper and should be withdrawn.

4. **Rejection of Claims 1-20 over Venable ‘785 or Venable ‘812 in view of WO ‘866 is *prima facie* improper.**

a. **This rejection provides no appropriate basis for combining WO ‘866 with Venable ‘785 or Venable ‘812.**

This rejection is *prima facie* improper because it provides no appropriate basis for combining WO ‘866 with either Venable ‘785 or Venable ‘812. As set forth in the Manual of Patent Examining Procedure (MPEP) at § 706.02(j), “To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, *either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings* (emphasis added) . . . The teaching or suggestion to make the claimed combination and the reasonable expectation of success *must both be found in the prior art and not based on applicant’s disclosure* (emphasis added). *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

The Office Action attempts to justify combining WO ‘866 with Venable ‘785 and Venable ‘812 based on the following conclusory statements:

Conclusory Statements

Alternatively, the secondary references disclose (note, in addition to the previously relied upon disclosure of Hubbard, paragraphs 0019 and particularly 0020, the latter which teaches applicant's preferred adhesive; WO '866, page 2, lines 22-25, page 3, lines 4-8, and Fig 2 and dry psa layer 12) the possibly missing element of a suitable solid, i.e. hot melt psa layer on the lower surface of the claimed laminate which is suitable for adhering the claimed covering material to a desired substrate, such as a suitable building structure. The references are believed to be clearly combinable, each taken from the roofing art which is clearly an example of a covering material, with the motivation being ease in application and use, together with the absence of harmful solvents or the like. Other parameters which are not expressly or inherently disclosed are again believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results (See Office Action. P. 4)

The above Conclusory Statements fail to properly to identify any text in WO '866, Venable '785, Venable '812 or any other reference that would provide any proper motivation for combining WO '866 with either Venable '785 or Venable '812. As stated by the Federal Circuit in *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000), "[d]etermining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness" (citing *Tec Air, Inc. v. Denso Mfg.*, 52 USPQ2d 1296, 1297-98 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with another)).

Furthermore, as noted by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references. (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.")).

With respect to the combination of WO '866 with Venable '795, the Office Action not only fails to identify any text in Venable '785 that would suggest that a person of ordinary skill in the art reading Venable '785 should read WO '866, but also fails to identify any portion of WO '866 that suggests that a person reading WO '866 should look

at Venable '785. Similarly, with respect to the combination of WO '866 with Venable '812, the Office Action not only fails to identify any text in Venable '812 that would suggest that a person of ordinary skill in the art reading Venable '812 should read WO '866, but also fails to identify any portion of WO '866 that suggests that a person reading WO '866 should look at Venable '812. Because the Office Action has articulated no proper basis for combining WO '866 with either Venable '785 or Venable '812, the rejection of Claims 1-20 over the combination of WO '866 with Venable '785 and the rejection of Claims 1-20 over the combination of WO '866 with Venable '812 are both *prima facie* improper.

b. This rejections are *prima facie* improper because they are based on improper hindsight.

Because no proper support in the references has been identified for the combination of WO '866 with Venable '785 or with Venable '812, it must be assumed that the Office Action is improperly relying on Applicant's own disclosure as a basis for combining WO '866 with Venable '785 and with Venable '812. Effectively, the combination of WO '866 with Venable '785 set forth in the Office Action presupposes the combination of WO '866 with Venable '785 and then provides a hindsight justification, found nowhere in the references, for this combination. Similarly, the combination of WO '866 with Venable '812 set forth in the Office Action presupposes the combination of WO '866 with Venable '812 and then provides a hindsight justification, found nowhere in the references, for this combination. These hindsight justifications are contrary to controlling Federal Circuit precedent in *Cardiac Pacemakers Inc. v. St Jude Medical Inc.*, 72 USPQ2d 1333, 1336 (Fed. Cir 2004) that "Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-79 [42 USPQ2d 1378] (Fed. Cir. 1997) ("However, the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination.").

In addition, the Office Action, in arguing that a person of ordinary skill in the art reading only Venable '785 would look at WO '866 only cites sections of WO '866 (see the Conclusory Statements quoted above). By only citing sections of WO '866, the Office Action, once again, presupposes that the person of ordinary skill in the art has improperly relied on the Applicant's disclosure to combine WO '866 with Venable '785, rather than looking at what WO '866 teaches or suggests in the absence of the Applicant's disclosure. Because it is based on improper hindsight, the rejection of Claims 1-20 over the combination of WO '866 and Venable '785 is *prima facie* improper.

Similarly, the Office Action, in arguing that a person of ordinary skill in the art reading only Venable '812 would look at WO '866 only cites sections of WO '866 (see the Conclusory Statements quoted above). By only citing sections of WO '866, the Office Action, once again, presupposes that the person of ordinary skill in the art has improperly relied on the Applicants' disclosure to combine WO '866 with Venable '812, rather than looking at what WO '866 teaches or suggests in the absence of the Applicants' disclosure. Because it is based on improper hindsight, the rejection of Claims 1-20 over the combination of WO '866 and Venable '812 is *prima facie* improper.

- c. **The rejection of Claims 1-20 over Venable '785 in view of WO '866 and the rejection of Claims 1-20 over Venable '785 in view of WO '866 should be withdrawn because it is *prima facie* improper.**

In summary, for at least the reasons discussed above, the rejection of Claims 1-20 over the combination of WO '866 with Venable '785 and the rejection of Claims 1-20 over the combination of WO '866 with Venable '812 are both *prima facie* improper and should be withdrawn.

F. Claims 1-20 have been Rejected based on Facts within the Personal Knowledge of the Examiner, and, therefore, Applicant Requests that the Examiner provide an Affidavit/Declaration under 37 C.F.R. § 104(d)(2).

- 1. The grounds alleged in Office Action's for rejecting Claims 1-20 over Venable '785 appears not to be based on what is taught by Venable '785, but instead on facts within the personal knowledge of the Examiner.**

While the Examiner alleges that Claims 1-20 have been rejected by the Examiner based on what is allegedly taught by Venable '785, Applicant's discussion in Section E(1) above suggests otherwise. Rather, the rejection of Claims 1-20 over Venable by the Examiner appears to be based not on what is taught by the Venable, but instead on the basis of facts within the personal knowledge of the Examiner. As discussed above in Sections E(1)(a)(ii) and E(1)(b)(ii), the Examiner has rejected Claims 1-20 over Venable '785 based on conclusory statements for which the Examiner has failed to provide support in the text of Venable '785.

- 2. The failure of the Examiner to identify in Venable '785 and/or WO '866 a proper basis for combining WO '866 with Venable '785 suggests this combination of references is based upon facts within the personal knowledge of the Examiner.**

As discussed above in Section E(4), Claims 1-20 have been rejected by the Examiner over the combination of WO '866 with Venable '785. As also discussed above in Section E(4), the Examiner has failed to identify in Venable '785 and/or WO '866 a proper basis for this combination of references. This failure to identify a proper basis for this combination of references suggests that this combination is actually based on facts within the personal knowledge of the Examiner.

- 3. The failure of the Examiner to identify in Venable '812 and/or WO '866 a proper basis for combining WO '866 with Venable '812 suggests this**

combination of references is based upon facts within the personal knowledge of the Examiner.

As discussed above in Section E(4), Claims 1-20 have been rejected by the Examiner over the combination of WO '866 with Venable '812. As also discussed above in Section E(4), the Examiner has failed to identify in Venable '812 and/or WO '866 a proper basis for this combination of references. This failure to identify a proper basis for this combination of references suggests that this combination is actually based on facts within the personal knowledge of the Examiner.

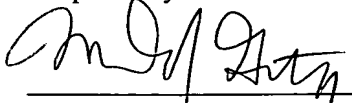
4. **Applicant requests that the Examiner either: (a) provide an Affidavit under 37 C.F.R. § 1.104(d)(2), or (b) withdraw the rejections of Claims 1-20.**

For at least the above reasons, Claims 1-20 have been rejected on the basis of facts within the personal knowledge of the Examiner. Accordingly, under 37 C.F.R. § 1.104(d)(2), the Applicant hereby requests that the Examiner either: (a) provide affidavit(s) or declaration(s) which contain these facts supporting each of the Examiner's unsupported assertions used as a basis for the rejections of Claims 1-20 or, (b) withdraw the rejections of Claims 1-20 based on the Examiner's unsupported assertions.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Mark J. Guttag at 703-591-2664, Ext. 2006.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,


Mark J. Guttag
Reg. No. 35,205

JAGTIANI + GUTTAG
Democracy Square Business Center
10363-A Democracy Lane
Fairfax, Virginia 22030
703-591-2664

December 29, 2005

CHISUM ON PATENTS

A Treatise on the Law of Patentability, Validity and
Infringement

VOLUME 1

Donald S. Chisum

Professor of Law
Santa Clara University
Santa Clara, California

2005

Filed Through:

RELEASE NO. 100, SEPTEMBER 2005

 LexisNexis™
Matthew Bender®

It is generally assumed that a United States patent is effective as a statutory bar only as of its issue date, not the date the application for it was filed.⁴⁹ Section 102(e) and the *Milburn* doctrine in terms apply only to anticipation, that is, to disclosures in a United States patent to another the application for which was filed prior to the date of invention.⁵⁰ Thus, an applicant may use a Rule 131 affidavit to avoid a prior domestic filing date, even though it is more than one year prior to the application date.

[2]—Derivation—The Inventor's Own Prior Work

An inventor's own prior work will not anticipate his later invention unless that prior work is such as to constitute a statutory bar. Thus, an applicant or patentee may eliminate a reference not constituting a statutory bar by showing that its disclosures derive from his own work. He need not establish completion of his invention prior to the reference.

[a]—Meaning of "Another." All the novelty provisions relate to the prior activity of someone other than the applicant or patentee. Section 102(g)(2) refers to prior invention "by another inventor." Section 102(e) refers to a United States patent granted on an application for patent "by another." Section 102(a) refers to the invention known or used "by others."

Literally, section 102(a) makes a prior patent or description in a printed publication an anticipation without excluding the work of the applicant or patentee. However, it is well settled that the applicant's own prior work will not anticipate his later invention unless that prior work is such as to constitute a statutory bar under Section 102(b).¹

⁴⁹ See § 5.03[2], § 6.02[3].

⁵⁰ See § 3.07.

§ 3.08[2]

¹ *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1581 n.47, 1 USPQ2d 1593, 1608 n.47 (Fed. Cir. 1987) (citing *Treatise*; inventions made by the same inventive entity and contained in copending applications are not prior art as to each other); *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986) (citing *Treatise*); *In re DeBraun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982); *In re Katz*, 687 F.2d 450, 454, 215 USPQ 14 (CCPA 1982) ("Thus, one's own work is not prior art under § 102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under § 102(a). Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed (or subject matter obvious therefrom) only when the disclosure occurred more than one year prior to the date of the application . . ."); *Illinois Tool Works, Inc. v. Solo Cup Co.*, 461 F.2d 265, 172 USPQ 385 (7th Cir. 1972); *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971); *Purdue Pharma L.P. v. Boehringer Ingelheim GmbH*, 98 F. Supp.2d 362, 55 USPQ2d 1168 (S.D. N.Y. 2000), *aff'd*, 237 F.3d 1359, 57 USPQ2d 1647 (Fed. Cir. 2001) (quoting *Treatise*); *AMP Inc. v. Fujitsu Microelectronics Inc.*, 853 F. Supp. 808, 31 USPQ2d 1705 (M.D. Pa. 1994), discussed at § 2.03[3] (prior patent to A is not prior art to claims in a second patent naming A and B as joint inventors if A was the sole inventor of

In determining whether prior work is in fact by "another," the theory of the inventorship entity must be applied.² The sole work of one person is usable against the joint work of that person with another. Similarly, the joint work of two or more persons is usable against the sole work of both and against the joint work of any other inventorship entity.

The general theory of separate inventorship entities appears to be confirmed by the legislative history behind the 1984 amendments to 35 U.S.C. Sections 103 and 116.³ The amendment to Section 103 provides that in certain limited

the subject matter of those claims); *Ex parte Oetiker*, 23 USPQ2d 1641 (Bd. Pat. App. & Int'l 1991), *aff'd*, 951 F.2d 1267, 23 USPQ2d 1661 (Fed. Cir. 1991) (unpublished); *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 226 USPQ 466 (D. Del. 1985), *aff'd*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986) (citing *Treatise*); *Clairol Inc. v. Save-Way Indus., Inc.*, 210 USPQ 459 (S.D. Fla. 1980) (prototype developed by one joint inventor as stage in development of invention does not constitute prior art); *Oetiker v. Jurid Werke GmbH*, 209 USPQ 809, 823 (D. D.C. 1981), *aff'd*, 671 F.2d 596, 215 USPQ 21 (D.C. Cir. 1982); *General Motors Corp. v. Toyota Motor Co.*, 467 F. Supp. 1142, 205 USPQ 158 (S.D. Ohio 1979), *rev'd on other grounds*, 667 F.2d 504, 212 USPQ 659 (6th Cir. 1981), *cert. denied*, 456 U.S. 937 (1982) ("a reference may constitute Section 102 pertinent prior art only if it was developed by an entity which is different from the one which developed the patent-in-suit"); *Kistler Instrumente AG v. United States*, 203 USPQ 511 (Ct. Cl. Trial Div. 1979), *aff'd*, 628 F.2d 1303 (Ct. Cl. 1980); *Ex parte Imris*, 218 USPQ 657 (PTO Bd. App. 1982) *Ex parte Lemieux*, 115 USPQ 148 (Pat. Off. Bd. App. 1957).

Cf. C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998), *reh'g denied & suggestion for reh'g in banc declined*, 161 F.3d 1380 (Fed. Cir. 1998); *cert. denied*, 526 U.S. 1130 (1999).

See generally Walterscheid, "The Ever-Evolving Meaning of Prior Art (Part 5)," 65 J. Pat. Off. Soc'y 477 (1983); Rollins, "Return of 'One Man in the World'," 64 J. Pat. Off. Soc'y 481 (1982); Rollins, "Inventor's Own Prior Inventions as Prior Art," 64 J. Pat. Off. Soc'y 352 (1982).

But cf. *Parker v. Flook*, 437 U.S. 584, 198 USPQ 193 (1978), discussed at § 1.03[6][e], in which the Supreme Court held that a mathematical algorithm or law of nature contained in a claim must be treated as prior art in determining patentability even where the claimant derived that algorithm or discovered that law. In *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981), discussed at § 1.03[6][g], the Court seemed to back away from its prior art statement in *Flook*: such an analysis "would, if carried to its extreme, make all inventions unpatentable because all inventions can be reduced to underlying principles of nature which, once known, make their implementation obvious." 450 U.S. at 189 n.12.

² See § 2.03[1]. *Itron, Inc. v. Cellnet Data Systems, Inc.*, 34 F. Supp. 2d 1135, 1144 (D. Minn. 1999), *aff'd*, 243 F.3d 563 (Fed. Cir. 2000) (unpublished) ("the '107 patent, which names Johnson and Wiebe as co-inventors, is an application for patent filed by 'another' as to the '094 patent naming Johnson, Wiebe, and five other inventors."); *De Graffenried v. United States*, 20 Cl. Ct. 458, 467, 16 USPQ2d 1321, 1328 (U.S. Cl. Ct. 1990) (quoting *Treatise*); *Ex parte DesOrmeaux*, 25 USPQ2d 2040, 2043 (Bd. Pat. App. & Int'l 1992) (rejecting argument that the 1984 amendment to Section 120 "tacitly . . . changed the words 'he' in 35 U.S.C. 102(f) and 'another' in 35 U.S.C. 102(g)"). One decision holds that this rule does not apply when the first inventorship entity did not apply for a patent on the prior work. See *Shields v. Halliburton*, 667 F.2d 1232, 216 USPQ 1066 (5th Cir. 1982), discussed *infra*.

³ See § 2.02[2], § 2.03[3], § 5.03[3][c][vi], § 9.05[4].

circumstances subject matter “developed by another person” that constitutes prior art only by virtue of Sections 102(f) and 102(g) shall not constitute prior art under Section 103. (A 1999 amendment to Section 103(c) added Section 102(e).) The legislative history of the 1984 Act states that “The term ‘another’ as used in this amendment means any inventive entity other than the inventor.”⁴

In *In re Land* (1966),⁵ Land and Rogers filed an application as joint inventors on February 13, 1956, for certain “photographic color processes.” Among the references cited by the Patent and Trademark Office against the Land-Rogers application were patents to Land and Rogers individually with prior filing dates. All the applications and patents were assigned to a common assignee, Polaroid Corporation. The Court of Customs and Patent Appeals held that each of these references was an application “by another.” Land, Rogers, and Land-Rogers (joint inventors) are discrete inventorship entities. In order to remove those patents as references under Section 102(e) and 103, Land-Rogers bore the burden of proving that their joint work dated back prior to the filing date of the Land and Rogers sole applications or that the unclaimed disclosures in those applications derived from their joint work.

Use of the theory of the inventorship entity in this context is severely criticized by one commentator.⁶ Often all the applicants are at work on a common research

⁴ “Section-by-Section Analysis of H.R. 6286, Patent Law Amendments Act of 1984,” Congressional Record, Oct. 1, 1984, H10527, reproduced in Appendix 22.

⁵ *In re Land*, 386 F.2d 866, 151 USPQ 621 (CCPA 1966).

Cf. *In re Kaplan*, 789 F.2d 1574, 1575, 229 USPQ 678, 679 (Fed. Cir. 1986) (“It is a given . . . that a sole inventor and joint inventors including the sole inventor are separate ‘legal entities,’ a legal proposition from which certain legal consequences flow . . . ‘such as who must apply for patent.’ ”); *In re Krank*, 438 F.2d 609, 168 USPQ 41 (CCPA 1971) (foreign inventors); *Helene Curtis Indus. v. Sales Affiliates*, 233 F.2d 148, 158-59, 109 USPQ 159 (2d Cir. 1956); *Purdue Pharma L.P. v. Boehringer Ingelheim GmbH*, 98 F. Supp.2d 362, 380, 55 USPQ2d 1168, 1180 (S.D. N.Y. 2000), *aff’d*, 237 F.3d 1359, 57 USPQ2d 1647 (Fed. Cir. 2001), discussed *infra* (citing *Land*; “where the inventive entity listed on a prior art patent overlaps with the inventive entity listed on a later patent, but is not identical to the latter entity, the prior art patent constitutes a patent ‘by another’ pursuant to Section 102(e) and therefore is capable of anticipating the later patented invention.”); *Davis v. Uke*, 27 USPQ2d 1180, 1182 (Comm’r Pat. & Trademarks 1993) (a patent naming A and B as inventors “is prima facie prior art against” an application naming B and C); *Ex parte DesOrmeaux*, 25 USPQ2d 2040 (Bd. Pat. App. & Int’f 1992); *Ex parte Mark*, 12 USPQ2d 1904 (Bd. Pat. App. & Int’f 1989), discussed at § 3.07; *Ex parte Martin*, 215 USPQ 543 (PTO Bd. App. 1981). See § 9.05.

In *General Motors Corp. v. Toyota Motor Co.*, 667 F.2d 504, 212 USPQ 659 (6th Cir. 1981), *cert. denied*, 456 U.S. 937 (1982), the Sixth Circuit held that intermediate developments by different inventive entities did not constitute prior art as to the final patented development. The final development should be viewed as a joint invention of all the persons concerned. See § 2.02[2]. It rebuffed the defendant’s reliance on *In re Land*: “*Land* [does not indicate] that the prior inventions were in any way the product of concerted effort within a business entity.”

⁶ Lorenzo, “The Inventive Entity and the Law of Double Patenting,” 50 J. Pat. Off. Soc’y 519 (1968).

enterprise for a corporate employer. In such a context, it is unrealistic to presume that unclaimed disclosures in the first application are all attributable to the named inventor or joint inventors.

"In fact, the teachings, data, and examples making up the specification of a patent application may, in any specific instance, represent knowledge gleaned from all or less than all of the named inventors, from their co-workers, from the prior art, and even from the background knowledge of the attorney drafting the application."⁷

Thus, it is suggested that a joint application following a sole application (or a sole following a joint) not be considered an application by "another" within the meaning of Section 102(e) where there is co-pendency and a common assignee. Instead, the problem would be handled under the law of double patenting. This would simplify the application problems of the common assignee and remove the present incentive to delay filing so that all applications can be filed on the same date (which presumably removes the Section 102(e) problem).

The Fifth Circuit in *Shields v. Halliburton* (1982)⁸ held that the prior work of one inventor (Bassett) should not constitute prior art as to a later patent obtained jointly by that inventor and another (Bassett and Olsen) when the first inventor (Bassett) opted not to obtain a patent on that prior work. The court distinguished *Land* and other cases "where the first inventor filed for, or received a patent for his own work, and subsequently filed jointly with a collaborator for newer developments."

"The cases involving an inventor who first seeks a patent, and then seeks a subsequent joint patent are distinguishable for a fundamental reason. Under the statutes governing patentability, novelty is a condition of patentability. 35 U.S.C. § 102. Had Bassett sought a patent for his work on the McDermott platform he must have claimed that the process he had developed was an invention. Had Bassett then collaborated with Olsen, and sought a patent for their joint product they would have been declaring that their work constituted an invention. In such a situation each process would have to be the first of its kind. Accordingly, the validity of Bassett and Olsen's patent application would have to be established against Bassett's earlier one. However, as here, where Bassett does some work, seeks no patent, collaborates with Olsen, and subsequently they together seek a patent, the joint application declares that

Compare Sears, "The Corporate Patent—Reform or Retrogression," 22 Villanova L. Rev. 1085 (1977); Chisum, "Sources of Prior Art in Patent Law," 52 Wash. L. Rev. 1, 19 (1976). See generally Note, "Patent Law in the Context of Corporate Research," 8 J. Corp. L. 497 (1983).

⁷ 50 J. Pat. Off. Soc'y at 532.

⁸ *Shields v. Halliburton*, 667 F.2d 1232, 216 USPQ 1066 (5th Cir. 1982).

See also *Saes Getters S.P.A. v. Ergenics Inc.*, 17 USPQ2d 1581, 1587 n.13 (D. N.J. 1990), *aff'd*, 914 F.2d 270 (Fed. Cir. 1990) (unpublished).

their work submitted as a whole is a single invention—the first of its kind. Because they declare their work to be single, and first invention, as between the joint inventors there is no earlier invention or prior art against which the joint invention need be established. Thus, the validity of a joint patent issued to two inventors who work in succession is consistent with the normal analytical framework of the patent laws.”⁹

The court noted that “if the ‘first’ inventor’s initial work for which no patent was sought constitutes an earlier invention as to any subsequent efforts with a collaborator, no valid joint invention would be possible. . . . Theoretically every joint invention would have to be the result of simultaneous inspiration by the collaborators.”¹⁰ The court emphasized two limitations on its holding. First, earlier work by “a stranger to the joint inventorship” might constitute prior art under Section 102 even though that stranger did not apply for a patent.¹¹ Second, the prior work of a member of the subsequent inventorship entity would constitute prior art if it fit within the statutory bar provisions of Section 102.¹²

It should be noted that the language of the relevant statute—Section 102—provides no basis for distinguishing between patented and unpatented prior invention insofar as the definition of “another” is concerned.¹³ The holding in *Shields* could easily have been reached by either construing the prior unpatented work and later patented work as part of a single joint invention¹⁴ or by ruling that the prior work by “another” was abandoned, suppressed or concealed within the meaning of Section 102(g).¹⁵

In *Applied Materials, Inc. v. Gemini Research Corp.* (1988),¹⁶ the Federal Circuit, in a short and ambiguous opinion, suggested that it might not strictly adhere to the theory of the inventorship entity (that is, the theory that distinct but overlapping groups of persons are to be treated as separate inventors in

⁹ 667 F.2d at 1236.

¹⁰ 667 F.2d at 1235.

¹¹ See § 3.05[4] and § 5.03[3][c][iii].

¹² See § 6.02.

¹³ Suppose Barrett’s prior work had been placed in public use or otherwise commercially exploited or described in a printed publication. It would seem appropriate to treat such matter as prior art as to a later independent and distinct invention by Barrett and another.

¹⁴ This is the approach adopted by the Sixth Circuit in a similar factual situation in *General Motors Corp. v. Toyota Motor Co.*, 667 F.2d 504, 212 USPQ 659 (6th Cir. 1981), *cert. denied*, 456 U.S. 937 (1982), discussed at § 2.02[2]. If this approach were adopted, the prior work of Barrett would not have constituted prior art under either Section 102(a) or 102(g)—even if embodied in a patent or publication. The only constraints would have been the double patenting doctrine (see Chapter 9) and the statutory bar provisions (see Chapter 6).

¹⁵ This approach is suggested at § 5.03[3][c][iii].

¹⁶ *Applied Materials, Inc. v. Gemini Research Corp.*, 835 F.2d 279, 5 USPQ2d 1127 (Fed. Cir. 1987), *reh’g granted, opinion modified*, 15 USPQ2d 1816 (Fed. Cir. 1988).

determining what is a prior art reference of "another") when there is overlap between two groups of inventors. However, the court subsequently granted rehearing and amended its opinion to avoid the inventorship entity issue.

Applied Materials involved the issue whether a patent (the '712 patent) to two inventors (McNeilly and Benzing) constituted prior art under 35 U.S.C. Section 102(e) in determining the patentability of claims in another patent (the '313 patent) to an inventorship entity consisting of the two inventors and a third person (McNeilly, Benzing and Locke). In 1969, an application naming McNeilly and Benzing as joint inventors was filed. The application disclosed technology relating to chemical vapor deposition (CVD). Applied Materials was the assignee of the inventors' rights. The Patent and Trademark Office required that the application be restricted to one of three distinct inventions: (1) a radiation heated reactor ("RH reactor"), (2) a gas reactant reactor ("GR reactor"), or (3) a CVD coating process, which included both method and apparatus claims. Applied Materials elected to prosecute claims on the RH reactor invention and obtained a patent thereon in 1971 (the "'712 patent"). A divisional application naming McNeilly and Benzing was filed and resulted in another patent on the GR reactor (the '496 patent). A second divisional application was filed for the coating process. This second divisional application was followed by a continuation-in-part application "which, *inter alia*, included the addition of Locke as a third inventor."¹⁷ The PTO examiner entered a second restriction as to the apparatus and method claims. Applied Materials elected the apparatus claims. A divisional application was filed on the method resulting in a patent naming McNeilly, Benzing and Locke as inventors ('313 patent).

The district court granted summary judgment that the '313 patent (McNeilly-Benzinger-Locke) was invalid as anticipated by the '712 patent (McNeilly-Benzinger). It reasoned that the '712 patent was "prior art" of "another" under 35 U.S.C. Section 102(e) because of the different inventive entities. The Federal Circuit reversed, holding that "the '712 patent is not prior art as to the '313 patent." It noted that "the fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art." First, the court recited its holding in *Kaplan*:

"As this court held in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986):

"When the joint and sole inventions are related, as they are here, inventor A commonly discloses the invention of A & B in the course of describing his sole invention and when he so describes the *invention* of A & B he is

¹⁷ The Federal Circuit's opinion did not indicate what new matter, if any, the continuation-in-part application added to the original disclosure or whether any new matter was necessary to support any of the claims in the patent that issued on the application.

not disclosing "prior art" to the A & B invention, even if he has legal status as "another" [35 U.S.C. §102(e)].

Id. at 1576, 229 USPQ at 680; *quoting, In re Land*, 368 F.2d 866, 879, 151 USPQ 621, 633 (CCPA 1966). Even though an application and a patent have been conceived by different inventive entities, if they share one or more persons as joint inventors, the 35 U.S.C. § 102(e) exclusion for a patent granted to 'another' is not necessarily satisfied."¹⁸

The court then concluded its opinion with the following two paragraphs:

"In this case, since the applications which matured into the '712 and '313 patents all grew from the same original application and since the work of McNeilly and Benzing continued with the addition of Locke, the district court was in error in holding that the '712 patent was prior art against the '313 patent."

"Additionally the district court found that the invention claimed in the '313 patent was inherently disclosed in, and fully anticipated by, the '712 patent, and was 'not novel.' Because the '712 patent is not prior art as to the '313 patent, we do not reach these issues."¹⁹

Left unchanged, the court's opinion might have foretold a major shift in the traditional patent law theory of inventive entities—as reflected in the cited *Land* case. Subsequently, however, the court granted a petition for rehearing, deleted the two paragraphs and substituted the following:

"In this case the application which matured into the '712 and '313 patents all grew from the same original application. Accordingly, if the invention claimed in the '313 patent is fully disclosed in the '712 patent, this invention had to be invented before the filing date of the '712 patent and the latter cannot be 102(e) prior art to the '313 patent. *See Land*, 368 F.2d at 879, 151 USPQ at 633 ('When the 102(e) reference patentee ['712] . . . had knowledge of the joint applicants' invention ['313] by being one of them, and *thereafter* describes it, he necessarily files the application ['712] *after* the ['313] applicant's invention date . . .') (emphasis in original). Thus, the district court erred because its invalidity decision was based on the incorrect premise that the '712 patent was 102(e) prior art against the '313 patent."²⁰

Several distinct rationales were available to the court in *Applied Materials* to support its ruling that the first patent ('712) by one entity (McNeilly-Benzing) was not "prior art" under Section 102(e) as to the second patent ('313) by a different entity (McNeilly-Benzing-Locke).²¹ The first is that the specific subject

¹⁸ 835 F.2d at 281, 5 USPQ2d at 1129-30.

¹⁹ 835 F.2d at 281, 5 USPQ2d at 1129-30 (deleted on rehearing).

²⁰ Added on rehearing.

²¹ *In Purdue Pharma L.P. v. Boehringer Ingelheim GmbH*, 98 F. Supp.2d 362, 55 USPQ2d 1168

matter disclosed in the '712 McNeilly-Benzin patent that was used to reach the anticipation finding was in fact the work of the McNeilly-Benzin-Locke entity. This rationale was the holding in the *Kaplan* decision, which the *Applied Materials* decision cites and quotes. This rationale follows the well-established principles that an inventor's own work is not prior art unless it constitutes a statutory bar under Section 102(b) and that an applicant may eliminate a disclosure in a patent or publication by another by showing that the disclosure in fact derived from the applicant's own inventive work. (This rationale would not justify disregarding everything disclosed in the prior patent. It would only apply to the specific subject matter in fact derived from the inventive entity in question).

(S.D. N.Y. 2000), *aff'd*, 237 F.3d 1359, 57 USPQ2d 1647 (Fed. Cir. 2001). (citing *Treatise*), the Southern New York District Court, confronted with a fact pattern similar to *Applied Materials*, discussed the rationale of that decision and the extent to which it may have altered *In re Land*.

"On its facts, the *Applied Materials* decision is quite similar to the present case. It is less clear, however, whether the decision alters the general rule, applied in the *Land* decision, that an earlier patent is 'by another' within the meaning of Section 102(e) if the two inventive entities overlap but are not identical. It is unlikely that the Federal Circuit intended in *Applied Materials* to overrule that proposition, given that the *Applied Materials* decision cites *Land* with approval and makes no mention of reconsidering *Land*.

"Rather, *Applied Materials* holds that if a parent patent fully discloses an invention that in fact is the work of an overlapping inventive entity and that is claimed in a continuing application listing that entity, then the presence of that subject matter in the earlier patent indicates that the present invention was already in existence as of the filing date of the parent application. And on that rationale, the invention disclosed in the earlier patent does not constitute prior art capable of anticipating the present invention.

"In this context, [the patent owner] points out that, in order to prevail on its anticipation defense, [the accused infringer] must ultimately demonstrate that the [prior] patent discloses 'every limitation' of the patents in suit, either explicitly or inherently. *Atlas Powder*, 190 F.3d at 1346 (quoting *In re Scheiber*, 128 F.3d at 1477) (emphasis added). In other words, [the patent owner] argues, a necessary premise of [the accused infringer's] anticipation argument is that the patents in suit are 'fully disclosed' in the [parent] patent as contemplated by *Applied Materials*. Therefore, [the patent owner] reasons, assuming for the sake of argument that the [parent] patent discloses 'every limitation' of the later inventions and thereby 'fully disclose[s]' those inventions, *Applied Materials* is directly applicable to the present case, since (1) the inventive entities of the respective patents are overlapping, and (2) the additional inventor named in the later patents had knowledge of the later inventions at the time of the parent patent application. . . . Accordingly, [the patent owner] concludes, because *Applied Materials* is directly applicable, [the accused infringer's] anticipation defense must be rejected.

"[The patent owner's] reading of the disclosure requirement in *Applied Materials* is persuasive, given that the Federal Circuit rendered the decision in response to an anticipation defense and most likely had principles of anticipation in mind when it discussed the fact that the later invention was 'fully disclosed' in the parent patent application. [The patent owner's] reading is the simplest and most obvious interpretation of the decision, and rejection of [the accused infringer's] anticipation defense is appropriate on this basis alone."

98 F. Supp.2d at 381, 55 USPQ2d at 1181.

BEST AVAILABLE COPY

3-251

NOVELTY

§ 3.08[2][a]

The paragraph substituted on rehearing appears to adopt this theory because it emphasizes that the subject matter claimed in the '313 patent was fully disclosed in the '712 patent application (which was alleged to be prior art). From such disclosure and from the overlap in inventive entities (which meant that the '712 applicants derived their disclosure from the '313 applicants), the court inferred that the '313 invention was necessarily invented prior to the '712 filing date.

A second rationale is that the claims in the '312 patent are entitled to the filing date of the common parent application. The addition of a new inventor (Locke) in a continuation-in-part application does not necessarily deprive that application of the benefit of the filing date of a parent application. This is made clear by the 1984 amendment to Section 120.²² This rationale would implement the requirement under Section 102(e) that a prior patent by another have a filing date prior to the inventor's date of invention. The opinion in *Applied Materials* does not expressly rely upon this rationale. The court does not indicate whether some or all of the claims in the '313 patent were entitled to the benefit of the filing date of the parent application. The third inventor, Locke, was added in a continuation-in-part application, which may have added new matter necessary to support one or more of the claims in the patent. The court's original opinion indicated that the "work of McNeilly and Benzing *continued* with the addition of Locke" (emphasis added), an implication being that Locke's contribution may even have occurred after the filing date of the parent application.

A third rationale is that the technology disclosed and claimed in the two patents ('712 and '313) constituted joint inventions by the whole group—McNeilly, Benzing, and Locke.²³ (From this rationale it would follow that the '712 patent is in error in designating only McNeilly and Benzing.) This rationale could not apply if, in fact, Locke's contributions began after the filing date of the parent application.

A final and broader rationale is that work is not by "another", at least for purposes of Section 102(e),²⁴ if there is overlap between the two inventive entities. The court's original language, while ambiguous, arguably does adopt

²² See § 13.07. The addition of a third inventor in the continuation-in-part application would not deprive the expanded inventorship entity of entitlement to the filing date of the parent application if the parent application in fact disclosed the invention of the expanded application.

²³ This rationale tracks and expands upon the Sixth Circuit's decision in *General Motors Corp. v. Toyota Motor Co.*, 667 F.2d 504, 212 USPQ 659 (6th Cir. 1981), cert. denied, 456 U.S. 937 (1982).

²⁴ There is no statutory basis for distinguishing the concept of "another" in Section 102(e) (description in a patent issuing on a previously-filed application by "another") from that in Section 102(a) (prior knowledge, use, description in a publication, or patenting by "others") or Section 102(g) (prior invention by "another").

See *Ex parte DesOrmeaux*, 25 USPQ2d 2040 (Bd. Pat. App. & Int'f 1992).

this rationale. Such a rationale is similar to that adopted by the Fifth Circuit in *Shields v. Halliburton* (1982),²⁵ A major problem with attributing this rationale to *Applied Materials* is that it is directly contrary to the holding in *Land*, which is a precedent binding on a panel of the Federal Circuit.²⁶ The amended opinion steers away from this rationale.

In both the original opinion and the amended opinion, the court stressed that the two patents in question grew out of the same original application.²⁷

[b]—Proof of Derivation. An applicant may eliminate the disclosure in a patent or publication by another with an effective date prior to the applicant's filing date by establishing through satisfactory evidence that the disclosure in fact derived from his own original inventive work.²⁸ The applicant need not file

²⁵ 667 F.2d 1232, 216 USPQ 1066 (5th Cir. 1982).

²⁶ The Federal Circuit adopted the precedents of the Court of Customs and Patent Appeals, which decided *Land*, and indicated that it would not overrule applicable precedents except by *in banc* consideration (that is, by all the active judges of the Federal Circuit). *Applied Materials* was decided by a three-judge panel.

²⁷ Inclusion of the work of two related inventive entities in one patent application or patent may determine whether the work of one entity is prior art as to the other under Section 102(e). However, under current law, such inclusion should not determine whether the work of one entity is prior art under another subsection of Section 102. In the 1984 amendment to Sections 116 and 120, Congress expressly authorized inclusion of inventions by different inventive entities in a single application and the filing of continuing applications by an inventive entity different from that in a previously filed application. See § 13.07. Congress also excluded certain subject matter by related inventive entities from the definition of prior art for the purpose of determining obviousness under Section 103. See § 5.03[3][c][vi]. The legislative history of these amendments suggests that inclusion of inventions by different inventors in a single application will not affect whether the invention of one inventor is prior art to that of the other. Rather, the prior art issue is determined by reference to general principles, including the specific exclusion added to Section 103. Thus, if the work of related entities should not be considered as being by "another" for policy or other reasons, it should not matter whether a single or several patent applications are filed.

Similarly, when the work of the second related inventive entity is in the nature of post-filing date improvements on work by the first entity, as may have occurred in *Applied Materials*, it should not matter whether the new work is introduced in a continuation-in-part application or in a new application. In either instance, patent claims to the improvements will not be entitled to the filing date of the first application.

²⁸ See U.S. Patent & Trademark Office, Manual of Patent Examining Procedure § 715.01(c) (7th ed. 1998 rev. 2000):

"Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself or on his/her behalf. Since such a showing is not made to show a date of invention by applicant prior to the date of the reference under 37 CFR 1.131, the limitation in 35 U.S.C. 104 and in 37 CFR 1.131(a)(1) that only acts which occurred in this country or in a NAFTA or WTO member country may be relied on to establish a date of invention is not applicable. *Ex parte Lemieux*, 115 USPQ 148, 1957 C.D. 47, 725 O.G. 4 (Bd. App. 1957); *Ex parte Powell*, 1938 C.D. 15, 489 O.G. 231 (Bd. App. 1938). See MPEP § 716.10 regarding 37 CFR 1.132 affidavits submitted to show that the reference is a publication of applicant's own invention.

BEST AVAILABLE COPY

180

PATENTS

§ 3.08[2][a]

[2]—Derivation—The Inventor's Own Prior Work

[a]—Meaning of "Another"

Section 102(e) refers to a United States patent granted on an application for patent "by another."^{0.1}

^{0.1} See *Riverwood International Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1355–56, 66 USPQ2d 1331 (Fed. Cir. 2003) ("The statute explicitly states that the reference at issue must be 'by another.' Thus, just as a patent issued to the same inventive entity cannot be prior art by admission, an application issued to the same inventive entity cannot be prior art under section 102(e). See *In re Costello*, 717 F.2d 1346, 1349, 219 USPQ 389, 391 (Fed. Cir. 1983) ('An applicant may also overcome a reference by showing that the relevant disclosure is a description of the applicant's own work. The pertinent inquiry is under 35 U.S.C. § 102(e).') (footnote omitted); *In re Land*, 368 F.2d 866, 878, 151 USPQ 621, 632 (CCPA 1966).")

¹ *Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc.*, 322 F.3d 1335, 1346, 66 USPQ2d 1083 (Fed. Cir. 2003) (quoting *Treatise*: "it is 'well-settled' law that an inventor's own disclosure 'will not anticipate his later invention unless that prior work is such as to constitute a statutory bar under Section 102(b). Donald S. Chisum, 1 *Chisum On Patents* § 3.08[2][a] (1999)."); *Riverwood International Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1355, 1356, 66 USPQ2d 1331 (Fed. Cir. 2003) ("One's own work may not be considered prior art in the absence of a statutory basis."; "[A]n application issued to the same inventive entity cannot be prior art under section 102(e).").

[b]—Proof of Derivation

¹⁵ Cf. *Rapoport v. Dement*, 254 F.3d 1053, 1056–57, 59 USPQ2d 1215 (Fed. Cir. 2001) (a publication ("FPR Publication") by a junior party in an interference was not a Section 102(b) "statutory bar" to either the junior party or a senior party in the interference because it was dated less than a year prior to the filing dates of the junior party and senior party. "[B]ecause the FPR Publication was authored by [the junior party], it can be cited as prior art against [the senior party], but not against [the junior party]. 35 U.S.C. § 102 (1994); *In re Kaiz*, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982).")

²⁸ E.g., *Riverwood International Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 66 USPQ2d 1331 (Fed. Cir. 2003), discussed below.

In *Riverwood International Corp. v. R.A. Jones & Co.* (2003),³⁸ the Federal Circuit emphasized that "[a] court must look beyond the superficial fact that [prior patents] were issued to different inventive entities. What is significant is not merely the differences in the listed inventors, but whether the portions of the reference relied on as prior art, and the subject matter of the claims in question, represent the work of a common inventive entity."³⁹

"In [*In re DeBaun*, 687 F.2d 459, 462 (CCPA 1982),] the examiner rejected DeBaun's application as obvious in light of U.S. Patent No. 3,964,278 ('the '278 patent') issued to DeBaun and Noll less than one year before DeBaun's filing date. DeBaun submitted a declaration that he was the sole inventor of everything in the '278 patent that was relied on by the examiner